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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,078	05/23/2001	Jean-Pierre Sommadossi	06171.105022(NOV 1007)	9998

7590

03/26/2003

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EXAMINER

OWENS JR, HOWARD V *10*

ART UNIT

PAPER NUMBER

1623

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/864,078

Applicant(s)

SOMMADOSSI ET AL.

Examiner

Howard V Owens

Art Unit

1623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-129 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-129 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-3, 13-15, 19-21, 40-42, 46-48, 52-54, 64-66, 70-72 drawn to purine compounds, classified in class 536, subclass 27.21. Claims 28-30, 79-81, 91-93, 97-99, 103-105, 115-117, 121-123 drawn to a method of treating a Hepatitis C virus w/purine compounds, classified in class 514, subclass 45.
 - II. Claims 4-6, 16-18, 22-24, 43-45, 49-51, 55-57, 67-69, 73-75 drawn to pyrimidine compounds, classified in class 536, subclass 28.1. Claims 31-33, 82-84, 94-96, 100-102, 106-108, 118-120, 124-126 drawn to a method of treating a Hepatitis C virus w/pyrimidine compounds, classified in class 514, subclass 49.
 - III. Claims 7-9, 34-36, 59, 60, 85-87, 109-111 drawn to a compounds and method for treating a Hepatitis C virus, classified in class 536, subclass 27.14 and class 514, subclass 45+
 - IV. Claims 10-12, 37-39, 61-63, 88-90, 112-114 drawn to compounds and method for treating a Hepatitis C virus, classified in class 536, subclass 27.21+, and class 514, subclass 45+.

- V. Claims 25-27, 76-78, 127-129 are generic/linking claims, drawn to dosage, classified in class 514, subclass 45+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are two distinct nucleoside compounds used in treating a virus. Wherein the search for the purine compounds of Group I is divergent from that of the pyrimidine compounds in Group II.
3. Inventions III is distinct from Groups I, II and IV as it contains a multideoxy nucleoside compound in the compound/composition and corresponding method of treating a virus.
4. Group IV is drawn to include both purine and pyrimidine compounds; however, the species election set forth below requires that applicant elect either a purine or pyrimidine base. Should applicant elect a purine base, these compounds will be examined with Group I. Should applicant elect a pyrimidine base, these compounds will be examined with Group II.
5. Group V contains generic claims which will be examined with one of the elected Groups of I, II, III or IV.
6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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7. The examiner notes that a search and examination of the five inventions and distinct species would indeed impose an undue burden on the examiner of record.

8. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II, III and IV, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. This application contains claims directed to the following patentably distinct species of the claimed invention: ***

Species 1 - lipid, phospholipid, class 424, subclass 283.1+ .

Species 2- amino acid, class 530, subclass 300+ (compound) or class 514, subclass 2+ (bioaffecting/method of treating).

Species 3- carbohydrate, class 536, subclass 1.1+.

Species 4- cholesterol, class 424, subclass 1.45.

Species 5- peptide, 530 , subclass 300+.

Species 6 - purine, class 536, subclass 27.21.

Species 7 – pyrimidine, class 536, subclass 28.2.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 7-9 and 34-36 are generic.

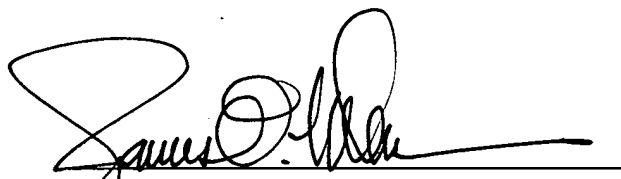
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Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Howard V. Owens
Patent Examiner
Art Unit 1623

A handwritten signature in black ink, appearing to read 'James O. Wilson', written over a horizontal line.

James O. Wilson
Supervisory Patent Examiner
Technology Center 1600

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Howard Owens whose telephone number is (703) 306-4538. The examiner can normally be reached on Mon.-Fri. from 8:30 a.m. to 5 p.m.

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If attempts to reach the examiner by telephone are unsuccessful, the Supervisory Patent Examiner signing this action, James O. Wilson can be reached on (703) 308-4624 . The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.